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09/213,131	12/15/1998	ERIC C. ANDERSON	1104-069	7384

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EXAMINER

AGGARWAL, YOGESH K

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER _____.

PATENT NUMBER _____.

TECHNOLOGY CENTER _____.

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Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

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(For Third Party HTC)

In re Application of Eric Anderson
Application No. 09/213,131
Filed: December 15, 1998

: **DECISION**
: **ON**
: **PETITIONS**

This is a decision on the patent owner's August 31, 2012 paper entitled "PETITION UNDER 37 § 1.182 TO REPLACE AN INFORMATION DISCLOSURE STATEMENT (IDS)," as supplemented on September 5, 2012, September 26, 2012, and October 18, 2012, and the patent owner's September 6, 2012 petition under 37 CFR 1.182 to expedite the treatment of its petition under 37 CFR 1.182 to replace the IDS and expunge confidential materials.¹

The decision also addresses the third party HTC's September 19, 2012 paper entitled "STATEMENT IN SUPPORT OF PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.182 TO REPLACE AN INFORMATION DISCLOSURE STATEMENT (IDS)."

The patent owner's petitions and HTC's letter are before the Office of Patent Legal Administration.

SUMMARY

1. The petition relief requested to expedite consideration of the petition to replace the IDS is **granted**.

¹ The Office, as soon as it was made aware of the issue on August 15, 2012, administratively provisionally sealed all documents associated with the relevant information disclosure statement pending resolution of the matter.

2. The petition relief requested to replace the IDS and expunge confidential materials is dismissed.
3. HTC's document will not be expunged at this time. If HTC states on the record that the document has not otherwise been made public, expungement will be granted. The manner of achieving expungement of HTC's document will be worked out in detail once the patent owner's full request is resolved.
4. The remaining documents listed in Appendix A that accompanied the August 31, 2012 petition will not be expunged as the patent owner (1) has not properly identified the remaining documents by clearly associating the documents that have been recently de-designated with the information disclosure statement, entry number and document description, and (2) has not shown that it has not waived confidentiality of its documents.
5. The IDS filed on July 29, 2011 will not be replaced or expunged.
6. The replacement information disclosure statements accompanying the patent owner's August 31, 2012 petition are being expunged from the record.

DECISION

I. Patent Owner's Petitions and Third Party HTC's Letter in Support Thereof

1. Patent Owner's August 31, 2012 Petition

On August 31, 2012, the patent owner (FlashPoint Technology, Inc.) filed a petition under 37 CFR 1.182 to expunge confidential information that was inadvertently submitted with the July 29, 2011 information disclosure statement (hereinafter "original IDS"). The patent owner asserts that the confidential information is subject to a protective order in International Trade Commission (ITC) Investigation No. 337-TA-726² and includes documents which have been determined to be confidential (designated as confidential business information or CBI) by the parties (including third party HTC) submitting them to the ITC.³ The documents that the patent owner asserts are under the protective order are listed in Appendix A that accompanied the August 31, 2012 petition.⁴ A copy of the protective order from the ITC investigation is included with the August 31, 2012 petition as Appendix C.⁵

The patent owner also requests that the original IDS be replaced by a redacted copy accompanying the August 31, 2012 petition as Appendix B.⁶ The patent owner states that "[t]here are 124 protected documents randomly (non-sequentially) distributed among 372 non-

²Patent owner's August 31, 2012 petition under 37 CFR 1.182 to replace IDS at 1.

³*Id.* at 2.

⁴*Id.* at 4.

⁵*Id.* at 5.

⁶*Id.* at 4.

patent literature documents in the original IDS.”⁷ To expedite expungement of the protected documents, the patent owner proposes that the Office expunge all documents associated with the original IDS, and that the patent owner, at the request of the Office of Petitions, will file the associated non-protected documents in a subsequent paper.⁸

Finally, patent owner asserts in the August 31, 2012 petition that the present reexamination proceeding is one of ten related cases in the Office and that petitions to replace an IDS are being filed in each of the ten related cases.⁹

2. Patent Owner’s First Supplemental Petition of September 5, 2012

On September 5, 2012, the patent owner filed its first supplement to its August 31, 2012 petition in order to clarify that at least one of the protected references designated as confidential by the patent owner belongs to the patent owner.¹⁰ However, the patent owner did not identify any protected references that belong to the patent owner. Instead, the patent owner asserts that it is waiting for its litigation counsel (Pepper Hamilton, LLP) to identify which of the protected references were designated as confidential by the patent owner and to determine whether any of the protected references (designated as confidential by patent owner or third parties) may now be re-designated as non-confidential by the patent owner, and that it will promptly submit this information as soon as it is available.¹¹ The patent owner also informed the Office that it “is attempting to determine (by a letter to the General Counsel of the Patent Office) whether any member of the public has requested a certified copy of the prosecution history in any” one of the 10 related cases and that “[a]s far as [p]atent [o]wner knows, only [p]atent owner has requested a certified copy.”¹² Patent owner also “requests that the current ‘freeze’ on public access to non-patent literature (including all of the protected references) associated with the above-identified cases be maintained in the above-identified matter until the Petitions to Replace are decided.”¹³

3. HTC’s Letter of September 19, 2012

On September 19, 2012, HTC filed a letter, at the invitation of patent owner, in support of patent owner’s August 31, 2012 petition. HTC confirmed in its letter that documents that were improperly submitted by the patent owner and labeled with the Bates number prefix “HTC_FP_ITC” are HTC’s confidential information that is covered by the terms of the protective order from the ITC investigation.¹⁴ HTC requests that patent owner’s petition to

⁷*Id.* at 8.

⁸ *Id.*

⁹The ten related cases listed on page 7 of the August 31, 2012 patent owner petition are 95/001,420, 95/001,431, 95/001,433, 90/010,834, 90/012,200, 90/012,090, 11/963,018, 09/213,131, 11/466,629, and 11/512,575.

¹⁰Patent owner’s first supplemental petition at 1.

¹¹*Id.*

¹²*Id.* at 2.

¹³*Id.* at 3. The Office, as soon as it was made aware of the issue on August 15, 2012, administratively provisionally sealed all documents associated with the relevant information disclosure statement pending resolution of the matter. However, there is no guarantee that the confidential documents, which were available in the Image File Wrapper (IFW) System of the Public Search Room prior to this date, were not downloaded by a member of the public before they were provisionally sealed by the Office.

¹⁴HTC’s September 19, 2012 letter at 1-2.

expunge and remove HTC's material "be granted so that the breach of the confidentiality of HTC materials can be contained or reduced."¹⁵ Finally, HTC asserts that "continued public disclosure of confidential HTC materials will be adverse to HTC's competitive business interests."¹⁶

4. Patent Owner's Second Supplemental Petition of September 26, 2012

On September 26, 2012, in response to HTC's September 19, 2012 letter identifying its specific information under ITC's protective order, the patent owner filed its second supplement to its August 31, 2012 petition to clearly and specifically identify that the 666-page document titled in the original IDS as "HTC id:01" and bearing the Bates ranges HTC_FP_ITC_0201095-HTC_FP_ITC_0201760 be expunged.¹⁷ The patent owner also included Exhibit A with the second supplemental petition, which identifies HTC's document as item number 29 in one of the PTO/SB/08a forms that was filed as part of the original IDS.¹⁸

5. Patent Owner's Third Supplemental Petition of October 18, 2012

On October 18, 2012, the patent owner filed its third supplement to its August 31, 2012 petition to inform the Office that some of the materials that were originally designated as confidential under the ITC's protective order and inadvertently included in the original IDS have been recently de-designated (i.e., designated as non-confidential) by the parties who produced the materials.¹⁹ Consequently, a number of documents previously at issue are no longer subject to the ITC's protective order.²⁰ The patent owner asserts that the remaining material previously identified as confidential under the ITC's protective order that were inadvertently included with the original IDS are still subject to the ITC's protective order and requests that these remaining materials be expunged.²¹ The third supplemental petition was accompanied by Exhibit B, which is a list of all references originally designated as confidential, and items on the list that are no longer subject to the protective order are highlighted by the patent owner.²² The patent owner also "agrees to store copies of all expunged documents that were designated as CBI by Patent Owner for the lifetime of the related patents."²³ The patent owner explains that since the ITC protective order "requires that, upon final termination of the 726 Investigation, all parties subject to the order destroy or return to the suppliers all items containing CBI that were produced pursuant to the Protective Order," the patent owner's "litigation counsel (Pepper Hamilton) cannot agree to retain copies of the expunged materials that were produced and designated as CBI under the Protective Order by any party other than Patent Owner itself."²⁴

¹⁵*Id.* at 2.

¹⁶*Id.*

¹⁷Patent owner's second supplemental petition at 1.

¹⁸*Id.* at 2.

¹⁹Patent owner's third supplemental petition at 1.

²⁰*Id.*

²¹*Id.*

²²*Id.* at 3.

²³*Id.*

²⁴*Id.*

In addition, the patent owner includes a letter from the Office of General Counsel dated October 4, 2012 (attached as Exhibit A) with its third supplemental petition. The letter was in response to the patent owner's September 6, 2012 request under the Freedom of Information Act regarding any requests for certified prosecution histories of the 10 related cases. The patent owner states that "[s]uch a request is the only way that a member of the public would be able to access non-patent literature associated with any of the impacted cases, including any of the documents that were designated as CBI and inadvertently included in the original IDS."²⁵ The patent owner asserts that the communication from the Office of General Counsel informed the patent owner that 7 of the 10 related cases had each received one request for certified copies of the file histories and that the remaining 3 cases had received no requests.²⁶

6. Patent Owner's Petition to Expedite

On September 6, 2012, the patent owner filed a petition to expedite the treatment of its August 31, 2012 petition to replace the IDS and expunge confidential materials. The patent owner asserts that the petition to expedite and its associated petition to replace the IDS "represent [p]atent [o]wner's best efforts to mitigate any public disclosure of the protected information via the Patent Office."²⁷ Patent owner states that it "learned on August 9, 2012 of this inadvertent submission of protected information to the Patent Office."²⁸ The patent owner asserts that "it is in the interest of all parties (the PTO, the Patent Owner, the Respondent in the ITC litigation, and other third parties)" that the Office expedite consideration of its petition to replace the IDS.²⁹

II. Analysis and Discussion

1. Patent Owner's Petition to Expedite is Granted

With respect to patent owner's petition to expedite consideration of its petition to replace the original IDS and expunge confidential material, the petition to expedite is **granted**.

2. The Original IDS Listing Will Not Be Expunged or Replaced

In response to the patent owner's request to replace the original IDS listing with a redacted copy, the patent owner has not asserted that the names of the documents covered by the ITC's protective order are confidential and there appears to be nothing confidential about the names of these documents. Therefore, the original IDS listing will not be expunged or replaced. To avoid confusion, the replacement information disclosure statements accompanying the patent owner's August 31, 2012 petition are being expunged from the record. As the documents to be expunged

²⁵*Id.* at 2.

²⁶*Id.* As indicated by the Office of General Counsel's letter dated October 4, 2012 (attached as part of Exhibit A to the patent owner's third supplemental petition), the 7 cases that received requests for certified copies of the file histories are 95/001,420, 95/001,431, 95/001,433, 90/010,834, 90/012,200, 90/012,090, and 09/213,131.

²⁷Patent owner's September 6, 2012 petition under 37 CFR 1.182 to expedite its August 31, 2012 petition at 2.

²⁸*Id.*

²⁹*Id.*

have already been made part of the Image File Wrapper (IFW) system of the present proceeding and cannot be physically returned, expungement is effected by permanently sealing the replacement information disclosure statements by closing them and marking them as non-public.

3. HTC's Confidential Information Will Not Be Expunged at This Time

As an initial matter, it is noted that HTC's September 19, 2012 letter is not entitled to entry under the rules – see 37 CFR §§ 1.501. HTC failed to suggest any provision of the regulations which could provide a basis for entry of its letter, and the Office can identify none. Thus, by rule, the HTC letter is an unauthorized paper. Pursuant to 37 CFR 1.183, however, “[i]n an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.” In the present instance, the September 19, 2012 letter seeks to protect HTC's confidential material consistent with the ITC's protective order. Further, the letter was presented solely to assert HTC's rights in protecting the confidentiality of its materials and in no way deals with the merits of the present application. In order to comply with the ITC's order to protect the rights of the parties to the investigation, the interests of justice require that the application entry right rules be *sua sponte* waived, and the Office is waiving the rules in order to enter and consider HTC's letter.

The Examiner of record, has completed review of the list of references included as Exhibit A in the August 31, 2012 petition and has determined with respect to the present application (now U.S. Patent No. 8,102,457) that the references for which expungement is currently being requested are not material to the patentability of the issued claims.

In view of the terms of the protective order, the irreparable harm to HTC that could be caused by public disclosure of the protected materials, and the facts and circumstances in this instance, HTC's 666-page confidential document labeled as “HTC id:01” and identified as item number 29 in the original IDS would be entitled to be expunged if the document has not otherwise been made public.

However, as there is no statement on the record that the document has not otherwise been made public, the document cannot be expunged at this time. HTC is called upon to submit a statement asserting that the document in question has not otherwise been made public. Entry right rules will be *sua sponte* waived to enter the filing of a paper solely responsive to this decision provided it does not deal with the merits of the proceeding.

4. The Documents will not be Expunged at this time

a. The Patent Owner Has Not Clearly Identified Which Documents Should be Expunged

The patent owner has not clearly identified the references to be expunged in the original information disclosure statement. The list of references provided in Appendix A that was submitted with the August 31, 2012 petition does not clearly identify that the references listed therein belongs to the original information disclosure statement filed in this proceeding. It is unclear whether IDS2 listed in Appendix A is the original IDS at issue in this proceeding. In contrast, the patent owner clearly identified HTC's document in the second supplemental petition by title and item number that is associated with the original information disclosure statement. Furthermore, some of these documents listed in Appendix A have been de-designated as confidential as indicated by Exhibit B accompanying the third supplemental petition. However, Exhibit B only gives the Bates Numbers and does not give the description of the references in the IDS, their item numbers or the number of pages that they each contain. The patent owner needs to provide a listing clearly identifying the references (in the IDS) that are covered by the ITC's protective order and linking these documents to the original IDS. One suggestion is to attach as an appendix in the renewed petition a copy of a redacted IDS and a separate document listing the redacted documents by their description in the IDS, their item number, the number of pages, and optionally, their Bates number.

Presumably, patent owner is now modifying its request and only seeks to expunge a subset of the documents first identified in Appendix A of the initial petition. Patent owner must provide a statement clarifying for which documents expungement is being requested, provide a clear listing identifying those documents, a statement that these documents were not otherwise made public and that the disclosure would result in irreparable harm to patent owner.

b. There Is Insufficient Information to Determine Whether the Documents Should Be Expunged

The present patent owner petition to replace the IDS and to expunge confidential material does not contain sufficient information to determine which documents listed in Appendix A accompanying the August 31, 2012 petition are actually not public, which documents are the patent owner's, and whether patent owner has waived the confidentiality of its own material under the terms of the ITC's protective order. Furthermore, the patent owner has not demonstrated that an extraordinary situation exists in which justice requires the requested expungement of its own material.

First, with respect to the public availability of the documents listed in Appendix A, this list of documents presents items that are likely to be public, such as the documents entitled "Apple Announces Apple Image Capture Platform" and "Resume, Autobiography, and Articles." The

ITC's protective order does not require that documents not be public and therefore, the patent owner or other third parties may have overdesignated the documents listed in Appendix A.³⁰

Second, the patent owner may have waived protection of its confidential material when the patent owner inadvertently made its confidential information public. Paragraph 6 of the ITC's protective order states in part:

Confidential business information furnished by a supplier may lose its protection under this order if it is disseminated to anyone not authorized to see it either by this protective order...

The patent owner has not shown that it has not waived the confidentiality of its material by its submission in 10 different proceedings, which was made publicly available since the filing date of the 10 IDSes (which had filing dates of July 18, 2011, July 19, 2011, July 25, 2011, July 29, 2011, August 10, 2011, September 9, 2011, September 15, 2011, April 2, 2012, and April 13, 2012) until August 15, 2012, when the Office provisionally sealed the documents listed on these IDSes. Furthermore, it appears from the results of the patent owner's FOIA request that the prosecution histories (including non-patent literature) of 7 of the 10 related cases have been disseminated to the public. It is unclear from the results of the FOIA request included in the third supplemental petition whether the confidential material was included in the prosecution histories as the confidential material was only provisionally sealed by the Office on August 15, 2012. Patent owner should note that the Office can only expunge information that is present within the authority of the Office. While the information at issue may be removed from USPTO records, information that exists in the public domain outside the Office's authority will remain in the public domain despite the Office's efforts with regard to this matter. The patent owner has not shown that it has investigated the extent of the disclosure or taken any steps to retrieve all the protected information.

Third, the information of the patent owner is recognized as being distinct from the information of third parties. The first supplemental petition filed on September 5, 2012 suggests that the effort to distinguish between information belonging to the patent owner and information belonging to third parties is an endeavor that has already begun. This distinction must be communicated to the Office before the requested expungement will be fully granted. Third parties should not directly submit petitions to the Office in this regard. Rather, the submission of such information should be coordinated by the parties involved and submitted as an attachment to a renewed petition filed on behalf of the patent owner. A renewed petition must clearly identify which information is that of the patent owner and which information is that of a third party.

Although the presence of the third party information that is subject to a protective order in the original documents may amount to an extraordinary situation in which justice requires the requested expungement of the third party information, there is no showing that these documents were not otherwise been made public. If the documents were otherwise public, there would be

³⁰ It is noted that the third supplemental petition indicates that some of the documents have been de-designated as confidential. However, because of the lack of adequate identification it is not evident that all public documents listed in Appendix A have been de-designated and the Office has no simple means for confirming this.

no basis for expungement. The document owners are called upon to clearly identify their documents and provide a statement that these documents have not otherwise been made public.

Accordingly, for the reasons set forth herein, the patent owner's petition to replace the original IDS and expunge confidential information is dismissed. The documents listed in Appendix A of the August 31, 2012 petition will not be expunged and the original IDS will not be replaced.

RECOURSE

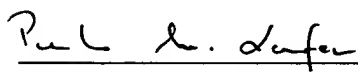
Patent owner is given a time period of one month or thirty (30) days, whichever is later, to file a renewed petition that provides the information requested in this decision. This period for reply is not extendable under 37 CFR 1.136(a). The renewed petition must identify: which information is that of the patent owner and which information is that of a third party, which information submitted to the Office is subject to the protective order, documents that are public, and documents that were used in the formation of patentability decisions by the examiner, and specific references by item number, description, and number of pages in the original information disclosure statement to be expunged.

HTC is given 30 days to submit a statement in response to this decision stating that HTC's 666-page confidential document labeled as "HTC id:01" and identified as item number 29 in the original IDS has not otherwise been made public.

CONCLUSION

1. The patent owner's September 6, 2012 petition to expedite consideration of its petition to replace the original IDS is granted.
2. The patent owner's petition to replace the IDS and expunge confidential materials is dismissed. The documents listed in Appendix A that accompanied the August 31, 2012 patent owner petition will not be expunged. The IDS filed on July 29, 2011 will not be replaced or expunged.
3. The replacement information disclosure statements accompanying the patent owner's August 31, 2012 petition are being expunged from the record by marking the papers "closed" and "not public."
4. The patent owner is given a time period of one month or thirty (30) days, whichever is later, to file a renewed petition that provides the information requested in this decision. This period for reply is not extendable under 37 CFR 1.136(a).
5. HTC is given a time period of one month or thirty (30) days, whichever is later, to file a statement in response to this decision stating that HTC's 666-page confidential document labeled as "HTC id:01" and identified as item number 29 in the original IDS has not otherwise been made public. This period for reply is not extendable under 37 CFR 1.136(a).

6. Inquiries regarding the present decision may be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711, or, in her absence, to the undersigned at (571) 272-7726.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

11/27/2012